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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,761	03/30/2001	Akihiro Furukawa	109133	3856
25944	7590	08/13/2004	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			ZHONG, CHAD	
			ART UNIT	PAPER NUMBER
			2152	

DATE MAILED: 08/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,761

Applicant(s)

FURUKAWA ET AL.

Examiner

Chad Zhong

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-8 are presented for examination.
2. It is noted that although the present application does contain line numbers in specification and claims, the line numbers in the claims do not correspond to the preferred format. The preferred format is to number each line of every claim, with each claim beginning with line 1. For ease of reference by both the Examiner and Applicant all future correspondence should include the recommended line numbering.

Drawings

3. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. The disclosure is objected to because of the following informalities:

Applicant is reminded of the proper language and format for an abstract of the disclosure. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 112, second paragraph

5. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. The following terms lack antecedent basis:

- i. the nodes – claim 1.
- ii. the corresponding node – claim 1.

b. The claim language in the following claims is murky or not clearly understood:

- i. As per claim 1, line 9, it is not clearly understood whether “a node” refers to “each node” in claim 1, line 5 (i.e. if they are the same, the word such as “said” or “the” must be used);
- ii. As per claim 5, line 9, it is not clearly understood whether “a node” refers to “each node” in claim 1, line 5 (i.e. if they are the same, the word such as “said” or “the” must be used);

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371 (c) of this title before the invention thereof by the applicant for patent.

7. Claim 1-3, and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Boucher et al. (hereinafter Boucher), US 6,434,620.

8. As per claim 1, Boucher teaches an IP address setting device:

a request packet transmitting unit that transmits a request packet to a particular multicast address, the request packet requesting transmission of an MAC address from each node of the network (Col. 26, lines

5-10; Col. 54, lines 30-41; Col. 56, lines 51-63);

a response reception unit that receives responses from the nodes to the request packet transmitted by the request packet transmitting unit, each response including the MAC address of the corresponding node (Col. 26, lines 5-10);

an address information designation unit that, based on the responses received from the nodes by the response reception unit, designates a node to be set with address information including an IP address and that designates the address information (Col. 26, lines 5-10, lines 16-32); and

a setting packet transmission unit that transmits a setting packet to the particular multicast address, the setting packet including the address information set by the address information designation unit and the MAC address included in the response from the node (Col. 26, lines 5-10, lines 16-32; Col. 7, lines 15-31; Col. 26, lines 5-10; Col. 54, lines 30-41; Col. 56, lines 51-63).

9. As per claim 2, Boucher teaches an IP address setting device as claimed in claim 1, wherein the address information designation unit includes:

a display that displays a list with at least a portion of nodes that transmitted response packets (Col. 56, lines 51-63);

a selection unit that enables a user to select from the list the node to be set with address information (Col. 84, lines 5-14; Col. 90, lines 28-37); and

an address information setting unit that sets address information separately to the selected node (Col. 84, lines 5-14; Col. 90, lines 28-37; Col. 26, lines 5-10, lines 16-32; Col. 7, lines 15-31; Col. 26, lines 5-10; Col. 54, lines 30-41; Col. 56, lines 51-63).

10. As per claim 3, Boucher teaches an IP address setting device as claimed in claim 1, wherein the address information designation unit includes a display unit that displays in a list at least a portion of network printers at nodes that transmitted a response packet (Col. 56, lines 51-63).

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11. As per claim 6, Boucher teaches an IP address setting method comprising:

judging whether the MAC address in the received setting packet is the same as the MAC address of the node; and

setting the address information in the setting packet as the address information of the node when the MAC address in the received setting packet is the same as the MAC address of the node (Col. 48, lines 51-65; Col. 63, lines 60-62; Col. 78, lines 51-67).

As per remainder of claim 6, Boucher teaches the other limitations as stated in rejection to claim 1 above.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 4-5, 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boucher et al. (hereinafter Boucher), US 6,434,620 in view of 'Official Notice'.

14. As per claim 4, Boucher teaches an IP address setting device as claimed in claim 1, the address information designation unit designates address information including an IP address, a subnet mask (Col. 26, lines 5-32).

15. Boucher does not explicitly teaches assignment of a gateway. "Official Notice" is taken that the concept and advantages of providing for assignment of a gateway is well known and expected in the art. It would have been obvious to one of ordinary skill in the art to include default gateway assignment with Boucher because it would provide for less burden on the administrator to assign gateways individually.

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16. As per claim 5, Boucher teaches an IP address setting device as claimed in claim 1, further comprising:

a response unit that transmits to the particular multicast address a response packet including an MAC address of a network printer connected at a node that is a member of the particular multicast address (Col. 26, lines 5-10, lines 16-32; Col. 7, lines 15-31; Col. 26, lines 5-10; Col. 54, lines 30-41; Col. 56, lines 51-63);

a packet reception unit that receives, at the node, packets from the particular multicast address and that determines whether a received packet includes the MAC address of the network printer (Col. 7, lines 17-31; Col. 48, lines 51-65); and

an IP address setting unit that, when the packet content determination unit determines that a received packet includes the MAC address of the network printer, sets the address information including the IP address in the setting packet as address information of the network printer (Col. 7, lines 17-31; Col. 48, lines 51-65; Col. 54, lines 30-41; Col. 26, lines 5-32).

17. Boucher does not explicitly teaches the notion of a network printer. "Official Notice" is taken that the concept and advantages of providing for network printer configuration is well known and expected in the art. It would have been obvious to one of ordinary skill in the art to include network printer configuration with Boucher because it would provide for easy administration for a printer device. Furthermore, a network printer is a network node in concept, the ability to configure IP addresses based on MAC addresses as is taught by Boucher would have been obvious to the ordinary skill in the art to be used on other network device such as a network printer.

18. As per claim 7, claim 7 is rejected for the same reasons as rejection to combination of claims 2 and 5 above respectively.

19. As per claim 8, claim 8 is rejected for the same reasons as rejection to combination of claims 1, 6

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and 5 above respectively.

Conclusion

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents and publications are cited to further show the state of the art with respect to

“Device and Method for using MAC address of networked devices to set IP addresses”.

- | | | |
|------|------------|------------------|
| i. | US 5982773 | Nishimura et al. |
| ii. | US 5835725 | Chiang et al. |
| iii. | US 6577642 | Fijolek et al. |
| iv. | US 6640251 | Wiget et al. |

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chad Zhong whose telephone number is (703) 305-0718. The examiner can normally be reached on M-F 7am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A Follansbee can be reached on 703-305-8498. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CZ
June 28, 2004


JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100